

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 32-57 are now present in this application. Claims 32, 45 and 54 are independent.

Amendments have been made to claims 45, 46, 48, 49, 50, 55 and 56. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

I. Election of Species Requirement/Withdrawal of Non—Elected Claims

The Examiner has made the Election of Species Requirement final, and has withdrawn claims 38, 41-43, 45, 47 and 49-51 from further consideration. With respect to claims 41 and 43, the Office Action asserts that neither of these two claims is readable on the elected species of Figs. 12-17. Initially, Applicants note that this conclusion is unsupported by any evidence or reasoning and, as such denies Applicants fundamental procedural and substantive due process which the Office is supposed to accord Applicants via the Administrative Procedures Act. See in this regard, *In re Zurko*, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and *In re Gartside*, 53 USPQ2d 1769 (Fed. Cir. 2000).

Under the circumstances, the final withdrawal of claims 41 and 43 from consideration is improper and the finality of this arbitrary and capricious action must be withdrawn.

Moreover, claim 41 clearly reads on the species of Figs. 12-17. In this regard, claim 41 recites that the fixing portion is a fixing member fixed at an inner wall surface of the hoistway. This feature reads on element 1c shown in Fig. 12, for example, and is described, for example, on page 20, lines 15-19.

Applicants agree that claim 43 does not read on the elected species of Figs. 12-17.

Applicant has not canceled the non-elected claims to preserve the right to file a divisional application with respect thereto.

II. Claim Amendments

Applicants have amended claims 46 and 56 in order to overcome the rejection of claims 46, 48, 56 and 57 under 35 USC §112, second paragraph and have not narrowed the scope of the claims in any way by this Amendment. Claim 48 has also been amended to remove an inadvertently added apostrophe, and claim 45 has been amended to correct a misspelling of "guide rails". The claim amendments are being made to clarify the fact that what is being claimed is a "2:3 roping method." The inclusion of "partial" in these claims was an inadvertency. Thus, the claims have been amended primarily to recite the subject matter therein more clearly.

III. Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 46, 48, 56 and 57 stand rejected under 35 U.S.C. §112, 2nd Paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language is not clearly understood. In particular, the Examiner repeats his assertion that "said roping means is roped by a partial 2:3 roping method," found in claims 46 and 56, renders those claims indefinite.

Applicants respectfully point out that this terminology is found in originally filed claims, including claims 28-30, for example, and therefore is part of Applicants' original disclosure.

Nevertheless, in order to overcome this rejection, Applicants have amended claims 46 and 56 to remove the modifier "partial" to correct the deficiency specifically pointed out by the Examiner. Applicants respectfully submit that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

IV. Rejections under 35 U.S.C. §103

Claims 32-37, 39, 44, 46 and 52-56 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 11-060117A in view of JP 4-50297Y2. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In rejecting claims under 35 USC §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed.

Cir. 1999). Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

The Office Action admits that JP 11-060117A, the primary reference in the rejection, does not disclose the claimed feature that the installation member is fixed on the upper portion of the counterweight guide rails.

In an attempt to remedy this deficiency, the Office Action turns to JP '297, which discloses an elevator with a traction sheave attached to the upper part of one or more counter weight guide rails 10, 11 and 11a.

The Office Action speculates, without identifying any evidentiary support for the speculation, that in JP '297, "having the installation member fixed on the

counterweight guide rails would allow the load in the vertical direction applied to the winding apparatus is absorbed by the guide rail thus cost for the building materials can be reduced."

The Office Action then concludes that it would be obvious to "have fixed the installation member of JP '117 on the upper portion of the guide rails in order to reduce the cost for the building material as taught by JP '297."

There are several reasons why this rejection fails to make out a *prima facie* case of obviousness of the claimed invention.

In the first place, as is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he or she advances. An Examiner may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The Office Action fails to indicate where JP '297 teaches that fixing an installation member on the counterweight guide rails would allow reduced building materials cost. In fact, no evidence is presented of the cost of materials involved in either of the two applied references.

Thus, the alleged motivation to modify JP '117 in view of JP '297 is not based on a factual basis with objective evidence to support it, but is based on improper speculation.

Moreover, even if the speculation in this regard were true, which it has not been shown to be, it is nothing more than a broad, general statement about costs of materials which does not constitute specific objective evidence which would properly motivate, i.e., give one of ordinary skill in the art the desire to modify JP '117, which apparently has no need to be modified to achieve its stated goal of eliminating a machine room, to achieve the claimed invention. See, in this regard, Dembiczak, cited above.

The Office Action also fails to point out the differences between these two references as required by Graham v. John Deere, cited above. Applicants note that there are significant differences between these two applied references. For example, and as noted in the rejection, JP '117 discloses a 2-to-3 roping ratio. The Office Action is silent, however, in the roping ratio of JP '297, which appears to be 2-to-4. The Office Action does not explain what roping ratio the resultant reference combination would have and whether leaving it the same in the resultant reference combination would work at all, or efficiently, or whether having to change the roping combination of JP '117 from 2-to-3 to 2-to-4 (as disclosed in JP '247) would offer enough of a disincentive to even making the proposed modification of JP '117.

A fair, balanced appraisal of the rejection reveals that it is improperly based on speculation including a cost savings theory that is not supported by any objective evidence, and the alleged motivation to modify the base reference in view of the secondary reference is also not supported by any clear and particular incentive to combine these references, but merely broad conclusionary speculative statements about cost savings. Accordingly, Applicants respectfully submit that this rejection is improper and should be withdrawn.

Similar comments are applicable to claim 41, which has been improperly withdrawn from consideration on its merits.

Reconsideration and allowance of claims 32-37, 39, 41, 44, 46 and 52-56 are respectfully requested.

V. Allowable Subject Matter

The Examiner states that claims 48 and 57 would be allowable if rewritten in independent form and to overcome the rejection under 35 USC §112, second paragraph.

Applicants thank the Examiner for the early indication of allowable subject matter in this application. However, claims 48 and 57 have not been rewritten in independent form at this time, since it is believed that independent claim 32 from which these claims depend is allowable for reasons stated, infra.

VI. Additional Cited References

Since the remaining references of record have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

VII. Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

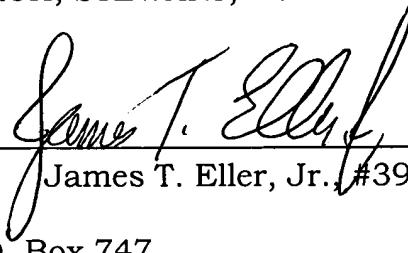
If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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